

Application Serial No.: 09/926,541
Reply to Office Action dated August 11, 2004

REMARKS

Favorable reconsideration of this application in light of the following discussion is respectfully requested.

Claims 16-18, 20, 21, 23, 25-29, and 31-40 are presently active in this case.

The Applicants respectfully request the withdrawal of the finality of the outstanding Official Action. MPEP 706.07(b) indicates when a final rejection is proper on first action. MPEP 706.07(b) indicates that the claims of a new application may be finally rejected in the first Office action in those situations where (A) the new application is a continuing application of, or a substitute for, an earlier application, and (B) all claims of the new application (1) are drawn to the same invention claimed in the earlier application, and (2) would have been properly finally rejected on the grounds and art of record in the next Office action if they had been entered in the earlier application. However, as discussed on pages 9-10 of the Amendment filed on July 20, 2004, Claims 37, 39, and 40 were added, which include a frangible notch feature that was not previously considered and would not have been properly finally rejected on the grounds and art of record. Accordingly, the Applicants respectfully request the withdrawal of the finality of the outstanding Official Action.

The issue of the withdrawal of the finality of the outstanding Official Action was discussed via telephone by Applicants' representative, Christopher Ward, with the newly assigned Examiner in this case, Examiner Colby Hansen, on February 2, 2005, and February 3, 2005. The Applicants note with appreciation that Examiner Colby Hansen indicated that the next Official Action would withdrawal the finality of the outstanding Official Action.

Application Serial No.: 09/926,541
Reply to Office Action dated August 11, 2004

The Applicants further submit that the outstanding Official Action did not appear to fully consider the Amendment filed on July 20, 2004. Newly added Claims 36-40 were not rejected, or even discussed in the Official Action contrary to MPEP 707.07(i). Thus, the Applicants have not been provided with the opportunity to address the rejection of the new claims. It is respectfully submitted that the next Official Action cannot be made final, since the Office Action did not provide the Applicants with the opportunity to address the rejection of the new claims.

Due to the assignment of a new Examiner to the present application, the arguments presented in the Amendment filed on July 20, 2004, are being reiterated herein for consideration by the newly assigned Examiner. Additionally, the Applicants respectfully request consideration of Claims 36-40.

In the outstanding Official Action, Claims 15-17, 20, 21, 23, and 25-28 were rejected under 35 U.S.C. 103(a) as being unpatentable over EP 489966. Claims 18 and 31 were rejected under 35 U.S.C. 103(a) as being unpatentable over EP 489966 in view of Bohler et al. (U.S. Patent No. 4,732,294). Claims 29, 30, and 32-35 were rejected under 35 U.S.C. 103(a) as being unpatentable over EP 489966 in view of Stolzman (U.S. Patent No. 4,471,453). For the reasons discussed below, the Applicants request the withdrawal of the obviousness rejections.

The Applicants submit that a *prima facie* case of obviousness cannot be established in the present case because the references, either taken singularly or in combination, do not teach or suggest all of the claim limitations. (See MPEP 2143.) Furthermore, the Applicants

Application Serial No.: 09/926,541
Reply to Office Action dated August 11, 2004

submit that there was no motivation to modify the cited references to arrive at the present application.

Claims 27 and 29 recite an industrial robot comprising a control system and a manipulator having an opening and a holder provided within the opening, where the holder is detachably fixed along or connected to a section of an edge of the opening and where the manipulator is provided with a pipe socket having the opening. Claim 28 recites a process for fastening in an industrial robot comprising detachably fixing a holder along a section of an edge of an opening, where the manipulator is provided with a pipe socket having the opening. The robot includes a control system. Such features are not disclosed or suggested by the cited references.

By way of illustration and not limitation, the present application describes a pipe socket (7) with an opening and one or more holders (9) detachably fixed along a section of the edge of the opening. The configuration of the present invention allows for cable sets to be passed through the opening and fixedly mounted to the pipe socket, whereby the risk of wear against the rim of the opening has been substantially reduced. The Applicants submit that the EP 489966 reference does not provide any such teaching.

The EP 489966 reference describes an industrial robot that includes an explosion-proof robot arm. The EP 489966 reference provides no information regarding the removing, installing, or exchanging of cable sets, and does not mention problems associated with the ability to draw one cable set internally through the robot without getting entangled with remaining cable sets. More importantly, the EP 489966 reference does not show a holder

Application Serial No.: 09/926,541
Reply to Office Action dated August 11, 2004

being detachably fixed along a section of an edge of an opening of a pipe socket, as recited in the claims of the present application. While the EP 489966 reference appears to depict a plate (8) provided within another plate (9), the EP 489966 reference clearly does not disclose a holder detachably fixed to an edge of an opening of a pipe socket. No such socket pipe or detachably fixation thereto is depicted in the EP 489966 reference.

Accordingly, the Applicants request the withdrawal of the obviousness rejections of Claims 27 and 28.

Regarding Claim 29, the Stolzman reference is cited for the teaching of a closure mechanism for covering an opening. The Stolzman reference describes a closure (16) connected to a sidewall end portion (13). However, the closure (16) is not configured to have at least one cable set extending therethrough. To the contrary, the feature (16) is intended to be a closure (as is evident from the name of element 16), and is not intended to hold a cable that extends therethrough. Thus, one of ordinary skill in the art would not have been motivated to combine the closure (16) with the teachings of the EP 489966 reference in order to arrive at the presently claimed invention. Furthermore, the Applicants further submit that the Stolzman reference is directed to a non-analogous art. The Stolzman reference is directed to a shipping and storage container. One of ordinary skill in the robotic arts would not have looked to such an art.

Accordingly, the Applicants request the withdrawal of the obviousness rejection of Claim 29.

Application Serial No.: 09/926,541
Reply to Office Action dated August 11, 2004

Claims 16-18, 20, 21, 23, 25, and 26 are considered allowable for the reasons advanced for Claim 27 from which they depend. These claims are further considered allowable as they recite other features of the invention that are neither disclosed nor suggested by the applied references when those features are considered within the context of Claim 27.

Claims 31-35 are considered allowable for the reasons advanced for Claim 29 from which they depend. These claims are further considered allowable as they recite other features of the invention that are neither disclosed nor suggested by the applied references when those features are considered within the context of Claim 29.

The Applicants also submit that the Bohler et al. reference is directed to a non-analogous art. The Bohler et al. reference is a safety latch for a filter assembly or pressure vessel. One of ordinary skill in the robotic arts would not have looked to such an art.

Claims 36-40 are considered allowable as they recite features of the invention that are neither disclosed nor suggested by the references of record. For example, the EP 489966 reference does not disclose a lid having removable sections *joined together by a frangible notch*, as recited in Claims 37, 39, and 40. (See directions or notches 15 in the figures and description on page 5, lines 17-21, for a non-limiting embodiment.) The Official Action concedes that the EP 489966 reference does not disclose a lid having removable section, but concludes that such sections would have been obvious, "since it has been held that constructing a formerly integral structure in various elements involves only routine skill in the art." However, the Applicants respectfully submit that the modification of the invention

Application Serial No.: 09/926,541
Reply to Office Action dated August 11, 2004

described in the EP 489966 reference to arrive at the present invention recited in Claims 37, 39, and 40 requires more than merely making various elements of a formerly integral structure. Claims 37, 39, and 40 do not include separate elements of a former integral structure, but rather provide a lid having new and advantageous structures. More specifically, the Claims 37, 39, and 40 provide a lid having removable sections joined together by a frangible notch, which allows a user to remove/break off pieces along the notch in order to make a versatile lid that is compatible with one or more holders depending upon the specific configuration needed by the user. Such removable sections are not taught or suggested by the EP 489966 reference. And, to the knowledge of the Applicants (note the reference is in German), the EP 489966 reference does not even suggest the need for such a feature. But rather, the lid of the EP 489966 reference appears to depict holes that are always open and the lid does not include removable sections that can be used to modify the configuration of the lid based upon the needs of the user.

MPEP 2143.01 states that the prior art must suggest the desirability of the claimed invention. As discussed above, the Applicants submit that the EP 489966 reference does not suggest the desirability of the removable sections recited in Claims 37, 39, and 40. Furthermore, MPEP 2143.01 notes that the fact that the claimed invention is within the capabilities of one of ordinary skill in the art is not sufficient by itself to establish *prima facie* obviousness.

Application Serial No.: 09/926,541
Reply to Office Action dated August 11, 2004

Consequently, in view of the above discussion, it is respectfully submitted that the present application is in condition for formal allowance and an early and favorable reconsideration of this application is therefore requested.

Respectfully Submitted,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, P.C.

Gregory J. Maier
Registration No. 25,599
Attorney of Record

Christopher D. Ward
Registration No. 41,367

Customer Number

22850

Tel. (703) 413-3000
Fax. (703) 413-2220
(OSMMN 10/01)

GJM:CDW:brf

I:\atty\cdw\216096US6 PCT\Request For Reconsideration.doc